

Applicant: Robert J. Peach, et al.
U.S. Serial No: 09/865,321
Filed: May 23, 2001
Page: 10

REMARKS

Claims 67-96 were pending. The U.S. Patent Office is requiring restriction of the claims under 35 U.S.C. §121. Applicants are adding new claims 97-115 herein. Accordingly, claims 67-115 are pending and being examined.

New claims 97-115 do not involve new matter and are supported by the specification as originally filed. Entry of these amendments is respectfully requested.

Support for new claim 97 can be found in the originally-filed specification of the subject application at page 4, lines 5-12; page 9, lines 25-27; page 10, lines 1-9 and lines 13-18; page 13, lines 21-30; page 14, lines 1-13; and Figure 7.

Support for new claim 98 can be found in the originally-filed specification of the subject application at page 11, lines 15-18.

Support for new claim 99 can be found in the originally-filed specification of the subject application at page 11, lines 19-27.

Support for new claim 100 can be found in the originally-filed specification of the subject application at page 11, lines 19-27.

Support for new claim 101 can be found in the originally-filed specification of the subject application at page 11, lines 23-25; and page 12, lines 14-19.

Support for new claim 102 can be found in the originally-filed specification of the subject application at page 9, lines 9-12; and page 11, lines 22-25.

Applicant: Robert J. Peach, et al.
U.S. Serial No: 09/865,321
Filed: May 23, 2001
Page: 11

Support for new claim 103 can be found in the originally-filed specification of the subject application at page 9, lines 12-13.

Support for new claim 104 can be found in the originally-filed specification of the subject application at page 12, lines 14-19.

Support for new claim 105 can be found in the originally-filed specification of the subject application at page 12, lines 14-19.

Support for new claim 106 can be found in the originally-filed specification of the subject application at page 12, lines 14-19.

Support for new claim 107 can be found in the originally-filed specification of the subject application at page 10, lines 8-9.

Support for new claim 108 can be found in the originally-filed specification of the subject application at page 10, line 7.

Support for new claim 109 can be found in the originally-filed specification of the subject application at page 10, line 7.

Support for new claim 110 can be found in the originally-filed specification of the subject application at page 4, lines 5-12; page 9, lines 25-27; page 10, lines 1-9 and lines 13-18; page 13, lines 21-30; page 14, lines 1-13; and Figure 7.

Support for new claim 111 can be found in the originally-filed specification of the subject application at page 12, lines 20-25.

Applicant: Robert J. Peach, et al.
U.S. Serial No: 09/865,321
Filed: May 23, 2001
Page: 12

Support for new claim 112 can be found in the originally-filed specification of the subject application at page 12, lines 20-28; page 13, lines 1-6; and Figure 7.

Support for new claim 113 can be found in the originally-filed specification of the subject application at page 28, lines 18-26.

Support for new claim 114 can be found in the originally-filed specification of the subject application at page 7, lines 9-10.

Support for new claim 115 can be found in the originally-filed specification of the subject application at page 10, lines 1-5; page 11, lines 10-14.

RESTRICTION REQUIREMENT

The Patent Office is requiring restriction to one of the following Groups of inventions:

Group I: Claims 67-80 and 94-96 which are directed to soluble CTLA4 mutant molecules and pharmaceutical compositions; classified in Class 530, subclass 350; or

Group II: Claims 81-93 are directed to isolated nucleic acid molecules encoding soluble CTLA4 mutant molecules, and vectors, host cells, methods of producing the mutant molecules; classified Class 435, subclasses 69.1, 455, 252.3 and 320.1.

Election with Traverse

Applicants hereby elects the invention of Group I with traverse. New claims 97-15 belong to the invention of Group I.

Applicant: Robert J. Peach, et al.
U.S. Serial No: 09/865,321
Filed: May 23, 2001
Page: 13

Reconsideration of the Restriction Requirement is requested for the following reasons:

Applicants point out that under MPEP §803, there are two criteria for a proper requirement for restriction, namely: (1) the invention must be independent and distinct; AND (2) there must be serious burden on the Examiner for restriction to be required.

Applicants respectfully contend that the second requirement of §803 has not been met. The Patent Office has not demonstrated a serious burden for searching the art of Groups I and II. The Examiner can perform a search on the entire application without serious burden. Thus, search of the art with regard to the invention of Groups I and II would not place an undue burden on the Examiner. Moreover, separate prosecution of these claims would be unnecessarily duplicative and thus wasteful of Patent Office resources. Therefore, under MPEP Section 803, the instant claims do not require restriction.

Applicants submit that claims of Groups I and II should properly be examined together for the reasons discussed above. Applicants respectfully request that the Examiner reconsider and withdraw the Restriction Requirement as these claims.

Conclusion

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone her at the number provided below.

Applicant: Robert J. Peach, et al.
U.S. Serial No: 09/865,321
Filed: May 23, 2001
Page: 14

A fee is deemed necessary in connection with the filing of this Communication. The undersigned attorney gives the U.S. Patent and Trademark Office authorization to charge the amount of \$ 342.00, to cover the fees for adding new claims 97-115, to Deposit Account No. 50-0306. The Patent Office is also authorized to charge any additional fee that is deemed necessary for filing this Communication.

Respectfully submitted,



Sarah B. Adriano
Registration No. 34,470
Roberta D. German
Registration No. 43,902
Patent Practitioners for Applicants
Mandel & Adriano
55 So. Lake Ave., Suite 710
Pasadena, California 91101
626/395-7801
Customer No: 26,941